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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,757	07/15/2003	Patrick J. Sweeney	029815-0101	7389
23524	7590	11/27/2006	EXAMINER PHILOGENE, PEDRO	
FOLEY & LARDNER LLP 150 EAST GILMAN STREET P.O. BOX 1497 MADISON, WI 53701-1497			ART UNIT 3733	PAPER NUMBER

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

N1

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/619,757	SWEENEY, PATRICK J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Pedro Philogene	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 September 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,8-16 and 27-41 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,8-10,13-16 and 27-41 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/8/06</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 13-16, 27-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Bryan et al. (6,156,067).

With respect to claims 1, 27, 30,33,38, Bryan et al disclose a stabilizing element (20) a scaffold assembly comprising a first base (42) and a second base (44) at least one appendage (110) removably attached to the first or the second base, such that the bases and the appendage forming a cage between the first and the second vertebrae, wherein the stabilizing element (20) is retained in the cage without being rigidly attached to the scaffold assembly; as set forth in column 3, lines 61-67, column 4, lines 1-67, column 5, lines 1-67, column 6, lines 1-67, column 7, lines 1-15; and as best seen in FIGS.1-14.

With respect to claims 2,3,13,14,28,29,34,35, Bryan et al disclose all the limitations, as set forth in column 3, lines 61-67, column 4, lines 1-67, column 5, lines 1-67, column 6, lines 1-67, column 7, lines 1-15; and as best seen in FIGS.1-14.

With respect to method claims 15,16,31,32,36,37,39-41, the method steps, as set forth would have been inherently carried out in the operation of the device, as set forth above.

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3,8-10,13-16,27-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Bryan et al. (7,025,787).

With respect to claims 1, 27, 30,33,38, Bryan et al disclose a stabilizing element (60) a scaffold assembly comprising a first base (22) and a second base (42) at least one appendage (70) removably attached to the first or the second base, such that the bases and the appendage forming a cage between the first and the second vertebrae, wherein the stabilizing element (60) is retained in the cage without being rigidly attached to the scaffold assembly, a first plate (20) and a second plate (40); as set forth in column 11, lines 5-67, column 12, lines 51-67, column 13, lines 5-35, lines 32-67; and as best seen in FIGS.1-38.

With respect to claims 2,3,8-10,13,14,28,29,34,35, Bryan et al disclose all the limitations, as set forth in column 11, lines 5-67, column 12, lines 51-67, column 13, lines 5-35, lines 32-67; and as best seen in FIGS.1-38.

With respect to method claims 15,16,31,32,36,37,39-41, the method steps, as set forth would have been inherently carried out in the operation of the device, as set forth above.

Claims 1-3,13-16,27-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Eberlein et al. (6,626,943).

With respect to claims 1, 27, 30,33,38, Eberlein et al disclose a stabilizing element (3) a scaffold assembly comprising a first base (1) and a second base (2) at

least one appendage (4) removably attached to the first or the second base, such that the bases and the appendage forming a cage between the first and the second vertebrae, wherein the stabilizing element (3) is retained in the cage without being rigidly attached to the scaffold assembly; as set forth in column 4, lines 1-67, column 5, lines 1-67, column 6, lines 1-33; and as best seen in FIGS.1-17.

With respect to claims 2,3,13,14,28,29,34,35, Eberlein et al disclose all the limitations, as set forth in column 4, lines 1-67, column 5, lines 1-67, column 6, lines 1-33; and as best seen in FIGS.1-17.

With respect to method claims 15,16,31,32,36,37,39-41, the method steps, as set forth would have been inherently carried out in the operation of the device, as set forth above.

***Response to Amendment***

Applicant's arguments, see Remarks, filed 9/8/06, with respect to the rejection(s) of claim(s) 1-3,8-10,13-16,27-41 under 102 have been fully considered and are persuasive. Also applicant's declaration under 37 C.F.R. 1.131 is acknowledged. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bryan et al/Eberlein et al.

***Conclusion***

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-

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4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
November 14, 2006

  
PEDRO PHILOGENE  
PRIMARY EXAMINER